

## **REMARKS**

### **Status Of Application**

Claims 1-19 are pending in the application; the status of the claims is as follows:

Claims 9 and 19 are withdrawn from consideration as being directed to a non-elected species;

Claims 7 and 17 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite;

Claims 11 and 14 are rejected under 35 U.S.C. § 102(a) as being unpatentable by U.S. Patent No. 6,721,107 B2 to Enomoto ("Enomoto");

Claims 15, 16, and 18 are rejected under 35 U.S.C. § 102(a) as being unpatentable by U.S. Patent No. 5,991,096 to Estelle ("Estelle");

Claims 1, 4, and 10 as being rejected under 35 U.S.C. § 103(a) as being unpatentable over Enomoto in view of Applicant's Admitted Prior Art ("AAPA");

Claims 5, 6, and 8 as being rejected under 35 U.S.C. § 103(a) as being unpatentable over Estelle in view of Applicant's Admitted Prior Art ("AAPA");

Claims 2, 3, 12, and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, is noted with appreciation.

By this response, allowable claims 2, 3, 12, and 13 have been rewritten in independent form, including all of the limitations of the base claim and any intervening claims, as suggested by the Examiner. That is, claims 2 and 3 have been amended to independent form including all of the limitations of claim 1. Similarly, claims 12 and 13 have been amended to independent form including all of the limitations of claim 11. Accordingly, in view of these amendments, it is respectfully requested that the objection to claims 2, 3, 12, and 13 as being dependent upon a rejected base claim, but allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, be reconsidered and withdrawn.

Also by this response, claims 1, 7, 11 and 17 have been canceled without disclaimer or prejudice. Further by this response, dependent claims 4-6, 8 and 9 have been amended to depend from allowable claim 2, while dependent claims 14-16, 18 and 19 have been amended to depend from allowable claim 12. Moreover, consistent with the foregoing, independent claim 10 has been amended to incorporate the limitations of allowable claim 3. Finally, new claims 20-24 have been added which depend from allowable claim 3 while new claims 25-29 have been added which depend from allowable claim 13.

Thus, by this response, it is believed that every claim has been rendered allowable because either the claim has been amended to depend from an allowable claim or the claim has been amended to incorporate the limitations of an allowable claim.

#### **Withdrawn Claims**

Claims 9 and 19 are presently withdrawn from consideration following the election of species requirement imposed in an Office Action dated March 7, 2006. That restriction requirement stated that Group I claims (1-8 and 10-18) were directed to a zoom lens having three lens units, as shown in figure 2, and Group II claims (9 and 19) were directed to a zoom lens having four lens units, as shown in figure 1. The restriction requirement also noted that claim 1 was generic.

It is respectfully submitted that allowable claim 3 is also generic. Accordingly, because a generic claim has been indicated as allowable, the withdrawn claims should now also be considered. This requirement does not impose any inconvenience on the Examiner because withdrawn claim 9 depends from allowable claim 2 and withdrawn claim 19 depends from allowable claim 12.

Moreover, by this response, new claims 24 and 29 have been added which are directed to the Group II (non-elected) species. However, like claims 9 and 19, the newly added claims also depend solely from allowable claims: (claim 24 depends from claim 3 and

claim 29 depends from claim 13). Accordingly, the requirement to consider these claims does not impose any inconvenience on the Examiner.

**35 U.S.C. § 112 Rejection**

The rejection of claims 7 and 17 under the second paragraph of 35 U.S.C. § 112 is considered moot in view of the cancellation of these claims. Accordingly, it is respectfully requested that the rejection of these claims be reconsidered and withdrawn.

**35 U.S.C. § 102(a) Rejections**

The rejection of claims 11 and 14 under 35 U.S.C. § 102(a) as being unpatentable by Enomoto, is respectfully traversed based on the following.

By this response, claim 11 has been cancelled and claim 14 has been amended to depend from allowable claim 12. Thus, the rejections of these claims should be moot. Accordingly, it is respectfully requested that the rejection of claims 11 and 14 under 35 U.S.C. § 102(a) as being unpatentable by Enomoto, be reconsidered and withdrawn.

The rejection of claims 15, 16, and 18 under 35 U.S.C. § 102(a) as being unpatentable by Estelle, is respectfully traversed based on the following.

By this response, Claims 15, 16 and 18 have all been amended to depend from allowable claim 12. Thus, the rejections of these claims should be moot. Accordingly, it is respectfully requested that the rejection of claims 15, 16, and 18 under 35 U.S.C. § 102(a) as being unpatentable by Estelle, be reconsidered and withdrawn.

**35 U.S.C. § 103(a) Rejections**

The rejection of claims 1, 4, and 10 under 35 U.S.C. § 103(a), as being unpatentable over Enomoto in view of AAPA, is respectfully traversed based on the following.

By this response, claim 1 has been cancelled and claim 4 has been amended to depend from allowable claim 1. Thus, the rejections of these claims should be moot.

Also by this response, claim 10 has been amended to incorporate the limitations of allowable claim 3. Thus, claim 10 should now be allowable for at least the same reasons as claim 3. Accordingly, it is respectfully requested that the rejection of claims 1, 4, and 10 under 35 U.S.C. § 103(a) as being unpatentable over Enomoto in view of AAPA, be reconsidered and withdrawn.

The rejection of claims 5, 6, and 8 under 35 U.S.C. § 103(a), as being unpatentable over Estelle in view of AAPA, is respectfully traversed based on the following.

By this response, claims 5, 6, and 8 have been amended to depend from allowable claim 2. Thus, the rejections of these claims should be moot. Accordingly, it is respectfully requested that the rejection of claims 5, 6, and 8 under 35 U.S.C. § 103(a) as being unpatentable over Estelle in view of AAPA, be reconsidered and withdrawn.

### **CONCLUSION**

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are respectfully requested.

This Amendment increases the number of independent claims by 2 from 3 to 5, increases the total number of claims by 7 from 18 to 25 (20 claims previously paid for), but does not present any multiple dependency claims. Accordingly, a Response Transmittal and Fee Authorization form authorizing the amount of \$250.00 to be charged to Sidley Austin LLP Deposit Account No. 18-1260 is enclosed herewith in duplicate. However, if the Response Transmittal and Fee Authorization form is missing, insufficient, or otherwise inadequate, or if a fee, other than the issue fee, is required during the pendency of this application, please charge such fee to Sidley Austin LLP Deposit Account No. 18-1260.


Application No. 10/649,537  
Amendment dated April 26, 2007  
Reply to Office Action of January 29, 2007

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley Austin LLP Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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